



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,266	02/07/2002	Leslie H. Swanson	3161.1000-001	9025
21005	7590	06/21/2006	EXAMINER	
HAMILTON, BROOK, SMITH & REYNOLDS, P.C.			GARG, YOGESH C	
530 VIRGINIA ROAD			ART UNIT	PAPER NUMBER
P.O. BOX 9133				3625
CONCORD, MA 01742-9133			DATE MAILED: 06/21/2006	

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/071,266	SWANSON, LESLIE H.
	Examiner	Art Unit
	Yogesh C. Garg	3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 10 April 2006.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1,2,4,19 and 20 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1,2,4,19 and 20 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Response to Amendment***

1. Applicant's amendment received on 4/10/2006 is acknowledged. Claims 1,4,19 and 20 are currently amended. Claims 3 and 7 are currently canceled. Claims 5-6, 8-18 are previously withdrawn. Currently claims 1-2, 4, and 19-20 are pending for examination.

### ***Response to Arguments***

2.1. Applicant's arguments filed 4/10/2006 regarding rejection of claims 1-4, 7 and 19 under 35 USC 101 have been fully considered but they are not persuasive. The current amendment to claim 1 does not remove the deficiency and as such these claims are rejected again under 35 U.S.C. 101 because the claimed inventions are directed to non-statutory subject matter, that is disembodied data structure claim which are per se not statutory. C.f. *In re Wamerdam*. The newly added limitations in claim 1, that is a content translator and a user interface represent mere computer codes/programs and do not include a computer readable medium in which these codes are embedded and are executable by a computer or processor.

2.2. Applicant's arguments, see Remarks, page 7, line 12-page 8, line 27, filed 4/10/2006, with respect to the rejection(s) of claim(s) 1, 19 and 20 under USC 103 (a) have been considered but are moot in view of the new ground(s) of rejection necessitated due to current amendments.

This is a Final Rejection.

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-2, 4 and 19 are rejected under 35 U.S.C. 101 because the claimed inventions are directed to non-statutory subject matter.

Claims 1-2, 4 and 19 are directed to disembodied data structure claim which are per se not statutory. C.f. *In re Wamerdam*. The body of the independent claims 1 and 19 are directed to a central database repository/ content translator/user interface which merely represent a code stored in a computer readable medium or in a text form on a paper. The examiner suggests to redraft the claims to include a computer readable medium so that the embedded code/program is executable by a computer or processor. A claim to a computer readable medium encoded with functional descriptive material that can function with a computer to effect a practical application that results in a useful, concrete and tangible result (i.e. running an assembly line or executing a stock transaction) satisfies Section 101. See U.S. Patent 5,710,578 to Beauregard etc. i.e., a set of instructions in combination with a computer system. C.f. *In re Wamerdam* - data structure stored in a computer memory, and *In re Lowery*, 32 USPQ2d 1031 (Fed. Cir. 1994) - data structure in a computer readable medium. Examples of Statutory Functional Descriptive Material are:

(a) A claimed computer-readable medium encoded with a functional data structure – this defines structural and functional relationships between the data structure and the hardware/software components. See Wamerdam.

(b) A claimed computer-readable medium encoded with a computer program - this defines structural and functional relationships between the computer program and the computer itself which allows the program's functionality to be realized provided that a useful, concrete and tangible result is realized. See U.S. Patent 5,710,578 to Beauregard et al.

Data merely stored in a computer readable medium to be read or outputted by a computer without any functional interrelationship, and thus do not impart functionality to the computer, i.e., they are not computer components. Examples of Non-Functional Descriptive Material :Music, Literature, Art, Photographs, Data base per se are directed to neither a "process" nor a "machine," but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only. Id. at 1551.

Dependencies of claim 1, that is claims 2 and 4 do not overcome the deficiency of claim 1 and therefore they are also rejected based on the same rationale.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, 4 and 19-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Van Etten et al. (US Patent 6,892,185), hereinafter Van Etten already cited in the previous office action mailed on 10/7/2005.

Note 1: Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Note 2: The recitation directed to an intelligent product catalog system for electronic creation, management and viewing of product information using a multimedia display system has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88

USPQ 478, 481 (CCPA 1951). In the instant case, the body of the claims 1-4, 7 and 19 are directed to a database which can stand-alone and does not depend on the preamble for its completeness.

**Regarding claim 1,** Van Etten teaches an intelligent product catalog system for electronic creation, management and viewing of product information using a multimedia display system comprising:

a central database repository for storing the product information providing for an unlimited number of product attributes and dynamic reconfiguration of the product information (see Figs. 1-2 and Figs. 9-10, col.4, lines 28-41, col.7, line 57-col.8, line 65 and col.9, line 15-col.11, line 9) wherein catalog database “32” and “30” Common Language Generator Knowledge databases correspond to claimed central database repository for storing the product information providing for an unlimited number of product attributes and dynamic reconfiguration of the product information (col.4, line 60-col.5, line 59)

the central database repository comprising a meta data system that describes the product information, a scheme system that defines entities and relationships inherent in the product information and an object model system that represents the product information (see Fig.1 and Figs. 9-10, col.4, lines 28-41, col.4, line 60-col.5, line 59 and col.9, line 15-col.11, line 9 ); and

a content translator for converting unstructured content to structured content based on the scheme system to create at least a portion of the product information (see Figs. 1 and 10 wherein “30” common language generator and CLG Knowledge

base corresponds to the claimed content translator. See also col.7, line 57-col.8, line

17 which discloses that "CLG" converts or normalizes free form data, that is  
unstructured data to normalized or structured data);

a user interface providing display, sorting and filtering of the product information  
including the unlimited number of product attributes (see Fig.2 and Fig.10 wherein "40"  
the buyer application interface corresponds to the claimed user interface)

**Regarding claim 2**, Van Etten discloses a plurality of applications accessing the  
central database repository, the applications being automatically adaptive to the  
dynamic reconfiguration of the product information (See at least col.7, line 57-col.8, line  
17 which discloses that "CLG" using predetermined rules updates and converts/  
normalizes free form data related to an item [that is unstructured data related to an  
item] to normalized or structured data based upon the information received from  
buyers, suppliers and changing market conditions).

**Regarding claim 4**, Van Etten discloses that specific products are selected  
based upon the product information, the selected products composing a system (see at  
least col.4, line 60-col.5, line 59 which discloses that the selection of item is done  
based upon the product's static, differentiating and dynamic attributes and its  
parameters. Further a product or item can correspond to a system, such as a computer  
system which will need attributes and parameters to be defined and selected ).

**Regarding claims 19-20**, their limitations are closely parallel to the limitations of claim 1 and are therefore, analyzed and rejected on the basis of same rationale used for claim 1.

***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent 6,836,894 to Hellerstein et al. (see at least col.4, lines 55-60), Foreign Patents DE 19955717 A1 to Leyman et al. (see at least Title and Abstract), and WO 00/72452 A2 to Brown (see at least Title and Abstract) teach converting unstructured data into structured data.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action: In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on M-F(8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Yogesh C Garg  
Primary Examiner  
Art Unit 3625

YCG  
6/16/2006